

REMARKS

Applicant has carefully studied the Office Action of March 26, 2004 and offers the following remarks to accompany the above amendments.

Before addressing the amendments and rejections, Applicant provides a brief summary of the present invention so that the remarks are considered in the proper context. The present invention is designed to facilitate communications links being initiated through events or interactions in a virtual reality environment. The exact type of communications link that is established is dependent on one of a number of factors. One factor is the virtual entity with which the interaction occurs. That is, for example, if a virtual file folder is touched, a file transfer may occur. Likewise, as an additional example, if a virtual phone is touched, a telephone call may be placed. A second factor is the conditions under which the interaction occurs. Conditions include time of day, date, real world location of real world entities, and the like. For example, if the interaction occurs after normal business hours, an email connection may be created rather than a telephone connection. Further, the present invention allows communication across a number of different communication links, including chat, telephone, email, calendar functions, file transfer, and the like.

Applicant herein amends claims 1, 16, and 47 to recite selecting a communications function based on conditional data. Claims 24, 26, 31, and 35 are amended to recite monitoring conditions to determine the conditional data. Claim 42 is amended to recite that the event notification is related to the conditional data. The amendment to include the conditional data is supported in the specification page 14, lines 8-13. No new matter is added. New claim 49 is added, which further defines the nature of the virtual entity to be a virtual object or a virtual location rather than an avatar. Support for this can be found on pages 3 and 6 of the specification which contrasts avatars from such virtual objects and virtual locations. New claim 50 is added, which further defines the type of conditional data which may be considered in establishing a communications function. Support for this can be found in the specification at page 14, lines 8-13. New claim 51 is added, which defines a particular sort of communications function. In all cases, no new matter is added. New claims 52 and 53 are added which relate the conditional data to the criteria of claim 10. Claims 11-13 are amended to depend from 52 to expand on the criteria.

Claims 1, 5-8, 15-17, 24, 26, 28-30, 35, and 39-48 were rejected under 35 U.S.C. § 102(e) as being anticipated by Matsuda et al. (hereinafter "Matsuda"). Applicant respectfully traverses. For the Patent Office to establish anticipation, the Patent Office must show where each and every claim element is located in the reference. Further, the elements of the reference must be arranged as claimed. MPEP § 2131. This is a strict standard.

Matsuda teaches a virtual environment for virtual pets that act as avatars for real world individuals. As explained at Matsuda col. 31, lines 1-25, when the avatars approach one another in a shared virtual space, the real world individuals may "chat" with one another in one of two fashions. The first is a public chat, wherein all users of the shared virtual space may "hear" the conversation. The second fashion is a private chat, wherein the private chat channel is established by clicking on the avatar of the real world individual with whom the clicker wishes to chat. The chat may be a voice chat or a text chat, although Matsuda does not specify how voice chat is selected in place of the text chat window of Fig. 27.

Matsuda does not teach or suggest selecting a communications function based on conditional data, wherein the communications function has been associated with the virtual event upon occurrence of the virtual event. That is, the only communication function that Matsuda teaches that is initiated upon the occurrence of a virtual event is the chat function, and the chat function is not selected based on conditional data as recited in the claims. As explained in the specification, conditional data comprises conditions such as time of day, date, and physical location of the real world entity. This is further clarified by claim 50.

Since Matsuda does not teach or suggest selecting a communications function based on conditional data, wherein the communications function has been associated with the virtual event upon occurrence of the virtual event, Matsuda does not teach or suggest a claim element and Matsuda cannot anticipate claims 1, 16 and 47.

Likewise, Matsuda does not teach monitoring for conditional data. Matsuda does not do anything with the conditional data and thus does not monitor for such data. Since Matsuda does not show this claim element, Matsuda does not anticipate the claims that recite this element (24, 26, and 35).

Similarly, Matsuda does not teach that the event notification is associated with the conditional data or that the communications function is determined based on the conditional data. This is because Matsuda is not concerned about the conditional data and cannot use it as part of

the decision calculus which selects or determines a communications function based thereon. As such, claim 42 is not anticipated.

The dependent claims are not anticipated by Matsuda at least for the same reasons. Applicant requests withdrawal of the § 102(e) rejection of claims 1, 5-8, 15-17, 24, 26, 28-30, 35, and 39-48 at this time.

Several claims deserve special mention. Claim 6 recites that initiating the communications function comprises initiating an email function. While Matsuda does disclose an email function at col. 26, lines 45-59, this email is not initiated upon occurrence of the virtual event as recited in the claim. Rather, the email function of Matsuda is sent to the user when the virtual life object reaches a new state (see Matsuda col. 29, lines 27-41). As is readily apparent, the email is not generated upon occurrence of the virtual event. To this extent, the reference does not show the claim element and the claim is independently not anticipated. Alternatively, if it is determined that the email of Matsuda corresponds the claim element, then the Matsuda email is not arranged as claimed, and thus the anticipation rejection still fails.

Claim 7 recites that initiating a communications function comprises initiating an electronic file transfer. While Matsuda does disclose a chat function at col. 31, and an email function at col. 26, these are not electronic file transfers as that term is commonly understood. While the Patent Office cites col. 8, lines 40-46 to discuss a browser VRML interaction, this too is not initiated upon occurrence of the virtual event and thus does not meet the recited claim element. To this extent, the reference does not show the claim element, and the claim is independently not anticipated.

Claim 15 recites in a Markush grouping the communications function. The Patent Office opines that telephony and email are shown in Matsuda Figure 8. While Figure 8 does show an email and telephone entry in the communication means, these communication means are not activated as a result of a virtual event. Rather, the communication means are, as previously explained, mechanisms to inform the real world entity of a change in state to the virtual pet, and not in response to a virtual event as recited in the claim. To this extent, the reference is not arranged as claimed and anticipation is improper.

Claim 29 recites, "select from a plurality of desired communications functions based on identifying the occurrence of a certain event." As discussed above, the only communication that Matsuda teaches as a result of the occurrence of the virtual event is the chat function. The chat

function is not the plurality of communications functions recited in the claim. While Matsuda does have other communications functions (such as email and fax in Figure 8), these communication functions are not invoked as a result of an event occurrence as recited in the claim and thus cannot be used to anticipate the claim. Since Matsuda's elements are not arranged as claimed, then Matsuda does not anticipate claim 29.

Claim 40 recites a "select one of a plurality of communications functions as the particular communications function based on a configuration value upon occurrence of the particular one of the event notifications." As explained above with respect to claim 29, Matsuda does not contemplate multiple communication modes and thus does not select one of a plurality of communications functions. Since Matsuda does not teach or suggest the claim element, Matsuda does not anticipate claim 40.

Claims 2-4, 9-14, 18-23, 25, 27, 31-34, and 36-38 were rejected under 35 U.S.C. § 103 as being unpatentable over Matsuda and further in view of Swartz. Applicant respectfully traverses. For the Patent Office to combine references in an obviousness rejection, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the references, and second, the Patent Office must support this motivation with objective evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Even if the combination is proper, the combination must still show all the claim elements to establish *prima facie* obviousness. MPEP § 2143.03. If the Patent Office cannot establish obviousness, Applicant is entitled to a patent.

Swartz is an IP telephony reference. The Patent Office at various places provides various rationales for combining Matsuda and Swartz. These rationales are not supported by the requisite actual evidence. Absent this evidence, the combination is improper. Since the combination is improper, the references must be considered individually. When considered individually, the references admittedly do not show all the claim elements and do not establish *prima facie* obviousness.

Specifically, the Patent Office opines (for claims 2 and 3) that the motivation was "to interact two virtual entities by placing a telephone call between them for the purpose of communications between them as suggested by Matsuda (Fig. 21) referenced by chat between 2 people." This motivation is not supported by the requisite actual evidence. Furthermore, if the motivation is to provide communications, Matsuda does such by providing the chat function. Therefore, the motivation does not compel the combination. Since the motivation does not

compel the combination, the combination is improper for at least two reasons, and the claims are allowable.

The Patent Office does not provide any motivation for claim 4. Thus, the references are not properly combinable and the claim is allowable.

The Patent Office opines for claim 9 that the motivation was, "to initiate multiple communication functions for a [sic] event by incorporating a communication options menu for the purpose of more reliable communications." This motivation is not supported by the requisite actual evidence and the combination fails for this reason. Absent such evidence, there is no reason to suggest that multiple communications functions are desirable in the context of the Matsuda system. Furthermore, there is nothing in the record that a communications options menu establishes more reliable communications. Since the proposed combination does not satisfy the motivation, then the combination is improper, and the claims are allowable.

The Patent Office opines for claim 10 that the motivation was, "to use a virtual reality event to initiate multiple communications functions based on a criteria by incorporating a call forwarding communication options menu for the purpose of greater success in establishing communications." This motivation is not supported by the requisite actual evidence and the combination fails for this reason. Absent such evidence, there is no reason to suggest that a call forwarding options menu is desirable in the Matsuda system. Furthermore, there is nothing in the record that a call forwarding communication options menu has greater success in establishing communications. In fact, the system of Swartz actually adds signaling overhead as the first communication effort must fail before the second effort is made using the "Follow Me" calling option. To this extent, the present invention is functionally superior to the combination proposed by the Patent Office.

The Patent Office does not provide any motivation for claims 11 and 12. To this extent the combination is improper and the rejection is not properly supported. Thus, the claims are allowable.

The Patent Office opines that the motivation to combine the references for claim 13 is "to initiate multiple communication functions based on a criteria by incorporating a call forwarding communication based on time of day for the purpose of greater success in establishing communications." Again, this motivation is not supported by the requisite actual evidence.

Absent such evidence, the combination is improper. As further explained above, the call forwarding system of Swartz is less efficient than the present system, and thus not as desirable.

The Patent Office opines that the motivation to combine the references for claim 14 is, "to interact two virtual entities by placing a call forwarded telephone call between them for the purpose of communications between them." This motivation is not supported by the requisite actual evidence. Further, the motivation does not compel the combination. Specifically, Matsuda allows communications between entities via the chat function, and thus already satisfies the motivation. Since the motivation does not compel the combination, the combination is improper. Since the combination is improper, the claim is allowable.

The Patent Office opines that the motivation to combine the references for claim 18 is, "to interact two virtual entities by placing a telephone call between them for the purpose of communications between them." This motivation is not supported by the requisite actual evidence. Further, the motivation does not compel the combination. Specifically, Matsuda allows communications between entities via the chat function, and thus already satisfies the motivation. Since the motivation does not compel the combination, the combination is improper. Since the combination is improper, the claim is allowable.

The Patent Office opines that the motivation to combine the references for claims 19 and 20 is, "to use virtual reality events to connect two parties by placing a telephone call using criteria based call forwarding option between the parties for the purpose of communications between them." This motivation is not supported by the requisite actual evidence. Further, the motivation does not compel the combination. Specifically, Matsuda allows communications between entities via the chat function, and thus already satisfies the motivation. Since the motivation does not compel the combination, the combination is improper. Since the combination is improper, the claims are allowable.

The Patent Office provides no motivation to combine the references for claim 21, and thus the combination is improper on this basis. Since the combination is improper, claim 21 is allowable.

The Patent Office opines that the motivation to combine the references for claim 22 is, "to incorporate selection from a multitude of communication functions to establish communication between two parties in a virtual reality environment." This motivation is not supported by the requisite actual evidence. Further, the motivation does not compel the

combination. Specifically, Matsuda allows communications between entities via the chat function, and thus already satisfies the motivation. Since the motivation does not compel the combination, the combination is improper. Since the combination is improper, the claim is allowable.

The Patent Office opines that the motivation to combine the references for claim 23 is, "to incorporate multiple avatar mappings for the user for the purpose of establishing different communication means between two parties in a virtual reality environment." This motivation is not supported by the requisite actual evidence. Since the combination is improper, the claim is allowable.

The Patent Office opines that the motivation to combine the references for claim 25 is, "to incorporate a plurality of communication functions dependent on a criteria for the purpose of improving the rate of establishing communication between two parties in a virtual reality environment." This motivation is not supported by the requisite actual evidence. Further, the combination does not satisfy the motivation. Specifically, paging adds a separate step to the establishment of communication (page first, then the paged party responds). This actually slows down the rate of establishing the communication, and thus does not satisfy the motivation advanced by the Patent Office. Since the combination does not satisfy the motivation, the combination is improper. Since the combination is improper, the claim is allowable.

The Patent Office opines that the motivation to combine the references for claim 27 is, "to interact two virtual entities by placing a telephone call between them for the purpose of communications between them." This motivation is not supported by the requisite actual evidence. Further, the motivation does not compel the combination. Specifically, Matsuda allows communications between entities via the chat function, and thus already satisfies the motivation. Since the motivation does not compel the combination, the combination is improper. Since the combination is improper, the claim is allowable.

The Patent Office opines that the motivation to combine the references for claims 32-34 is, "to incorporate call forwarding telephonic features to handle status conditions for the purpose of improved rate of establishing communications between multiple parties." This motivation is not supported by the requisite actual evidence. Further, the combination does not satisfy the motivation. Specifically, the call forwarding is invoked after a failed attempt. Adding this extra step actually slows the rate of establishing communications between parties. Further, the

motivation does not compel the combination. Matsuda allows communications between entities via the chat function, and thus already satisfies the motivation. Since the motivation does not compel the combination, the combination is improper. Since the combination is improper, the claims are allowable.

The Patent Office opines that the motivation to combine the references for claims 35-38 is, "to incorporate call forwarding and call in progress telephonic features to handle status conditions for the purpose of improved rate of establishing communications between multiple parties." This motivation is not supported by the requisite actual evidence. Further, the motivation does not compel the combination. Specifically, Matsuda allows communications between entities via the chat function, and thus already satisfies the motivation. Since the motivation does not compel the combination, the combination is improper. Since the combination is improper, the claims are allowable.

Even if the combinations are proper, the combination of references does not cure the underlying deficiencies of Matsuda. Specifically, nothing in Swartz teaches the selection of a communications function based on conditional criteria or monitoring the conditional criteria. Since the references individually do not teach or suggest the claim element, the combination of references does not teach or suggest the claim element, and the combination does not establish *prima facie* obviousness. Since the combination does not establish obviousness, Applicant is entitled to a patent.

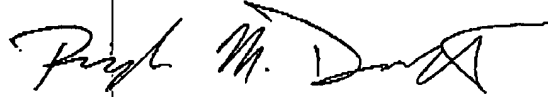
Applicant requests reconsideration of the rejection in light of the amendments and remarks presented herein. The references of record do not account for conditional data and do not render the claims obvious. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.



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